
By way of background, the following facts are noted:

At ¶1 of the Office Action, the Examiner referred to a paper no. 13 ("Notice Re Power of Attorney") to the effect that the Power of Attorney on file herein has not been accepted. As undersigned counsel for application related to USPTO Quality Assurance Specialist Douglas McGinty by telephone and by FAX in early October 2001, paper no. 13 was not received by counsel until Mr. McGinty, upon being so informed, FAXed paper no. 13 to undersigned counsel on or about 3 October 2001.

By the same token, upon being informed by undersigned counsel that applicant had promulgated a Status Inquiry herein on 1 December 2000, Mr. McGinty reported that no Status Inquiry was in the USPTO file. On 3 October 2000, undersigned counsel FAXed Mr. McGinty a copy of the 1 December 2000 Status Inquiry document.

**A. ASSIGNEE IS EMPOWERED
TO PROSECUTE THIS APPLICATION**

At ¶4 of the Office Action, the application is objected to under 37 CFR 1.172(a) on the grounds that the "assignee has not established its ownership interest in the patent for which reissue is being requested". Applicant responds as follows:

(1) As the first page of USP 5,609,938 (the patent sought to be reissued herein) recites, the sole inventor is Rodney M. Shields of Lafayette, CA, and assignee is Creative Minds Foundation of Wilmington, DE. (The attached Ross Declaration establishes that Ross was and is President of Creative Minds Foundation.)

(2) Attached hereto as EXHIBIT 1 is a true copy of the actual assignment document by which Rodney M. Shields on or about 23 June 1993 assigned to

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assignee Creative Minds Foundation. EXHIBIT 1 shows that the Assignment document was duly recorded at Reel 6648, Frame 0187 on 23 June 1993.

all right, title and interest in and to the invention and application and to all foreign counterparts (including patent, utility model and industrial designs), and all future improvements thereon, and in and to any Letters Patent and Registrations which may hereafter be granted on the same in the United States and all countries throughout the world The right, title and interest is to be held and enjoyed by Assignee and Assignee's successors and assigns as fully and exclusively as it would have been held and enjoyed by Assignor had this assignment not been made, for the full term of any Letters Patent and Registrations which maybe granted thereon, or any division, renewal, continuation in whole or in part, substitution, conversion, reissue, prolongation or extension thereof. (emphasis added)

Assignor further agrees that Assignor will ... (a) cooperate with Assignee in the prosecution of U.S. Patent applications and foreign counterparts on the invention and any improvements, (b) execute, verify, acknowledge and delivery all such further papers, including patent applications and instruments of transfer, and (c) perform such other acts as Assignee lawfully may request or obtain or maintain Letters Patent and Registrations for the intention and improvements in any and all countries, and to vest title therein in Assignee, or Assignee's successors and assigns.

(3) In view of the attached Assignment document, the above-quoted language clearly divests from Rodney M. Shields in favor of Assignee Creative Minds Foundation "all right, title and interest" in the subject invention in the underlying USP 5,609,938, including any "continuation in whole or in part" and any "reissue" thereof.

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As shown by the accompanying Ross Declaration, Rodney Shields' assignment of rights in the parent application and, inter alia, any continuation-in-part application(s) thereof (e.g., including USP 5,609,938) was but one of many assignments of intellectual property rights by Shields' in favor of Creative Minds Foundation and/or Clear Focus Imaging, Inc., entities in which Greg Ross had a corporate-level interest.

(4) For the record, undersigned counsel represents that all attempts to communicate with Rodney M. Shields concerning the within reissue application and specifically asking him to review the underlying application, amendment, and to execute and return a new Declaration and Power of Attorney (although such executed document is not necessary in view of EXHIBIT 1) have been unsuccessful.

(a) On 9 October 2001, undersigned counsel caused an envelope with first-class postage thereon containing the underlying application, amendment, and a letter from undersigned counsel to Mr. Shields asking him to review the underlying application and amendment (which were enclosed), and to execute and return an enclosed new Declaration and Power of Attorney to be mailed to Rodney M. Shields at 1139 Sierra Vista Way, Lafayette, CA 94549 has been returned by the U.S. Post Office as non-deliverable with the notation that Rodney M. Shields is "not known" at that address. (If the Examiner desires, the still unopened envelope bearing the U.S. Post Office Notation can be provided.)

(b) Undersigned counsel represents that attempts have been made to find a telephone number for Rodney M. Shields from the telephone company, from Internet databases, and from at least one subscription database, but to no avail.

(c) On or about 29 October 2001, a subscription database disclosed an address of 3142 Sweetbrier Circle, Lafayette, CA 94549 for a Rodney M. Shields. On that date undersigned counsel re-mailed copies of the documents originally mailed on 9 October 2001 and a re-dated cover letter to Mr. Shields again asking him to review the enclosed underlying application, amendment, and to execute and return an enclosed new Declaration and Power of Attorney. Although the 29 October 2001 mailing was not returned as non-deliverable, if it was delivered to inventor Rodney M. Shields, Mr. Shields has not contacted undersigned counsel. (If the Examiner desires, a copy of the documents mailed to Mr. Shields on 29 October 2001 can be provided.)

(d) The apparent lack of cooperation of Rodney M. Shields with undersigned counsel appears to be part of a pattern. The USPTO file herein includes a document entitled "Detail of Refusal of Non-Signed Inventor to Sign Application Papers", executed on or about 26 June 1999 by Thomas C. Feix, predecessor counsel herein, documenting Mr. Shield's expressed refusal to cooperate herein. Indeed, the USPTO file herein includes an 8 September 1999 "Decision According Status" document in which the USPTO acknowledges that:

the non-signing inventor (Rodney M. Shields) has refused to join in the filing of the above-identified application after having been presented with the application papers. In addition ... Creative Minds Foundation has a proprietary interest in the above-identified application ... (emphasis added)

(e) As noted, Mr. Shields' signature upon a new Declaration and Power of Attorney should not be required by virtue of the original Assignment (EXHIBIT 1). But assuming that Mr. Shields did indeed receive the 29 October 2001 mailing, then Mr. Shields' apparent failure to contact undersigned counsel (or indeed any person known to underlying counsel) is a breach of his express duty to "(a)

cooperate with Assignee in the prosecution of U.S. Patent applications ... on the invention and any improvements, (b) execute, verify, acknowledge and deliver all such further papers ... and (c) perform such other acts as Assignee lawfully may request to obtain or maintain Letters Patent ... for the invention and improvements ... and to vest title thereto in Assignee, or Assignee's successors and assigns". (See EXHIBIT 1)

(5) In view of the arguments and exhibits submitted in support of paragraph (4) above, undersigned counsel submits that Assignee herein is Creative Minds Foundation, an entity that is empowered, with or without cooperation from Rodney M. Shields (and there has been no cooperation) to execute a Revocation and Power of Attorney document authorizing undersigned patent counsel to continue the within patent prosecution. The Ross Declaration, submitted herewith, as well as other documents already on file herein (e.g., Statement Under 37 CFR §3.73(b) executed on 11 March 1999) establish that Greg Ross is President of Creative Minds Foundation, assignee herein, and is thus authorized to execute documents including a Revocation and Power of Attorney document on behalf of Assignee Creative Minds Foundation.

The Examiner has cited MPEP §306 for the proposition that a prior assignment is not applied to a continuation-in-part application. But the Examiner and the generalized language of MPEP §306 overlook the very explicit language of the Shields' Assignment (EXHIBIT 1). For example, MPEP §306 states that the reason a prior assignment is not applied to a continuation-in-part application is because:

the assignment recorded against the original application gives the assignee rights to only the subject matter common to both applications.

But inventor Shields and Assignee Creative Minds Foundation had the legal right to draft an Assignment document as they saw fit, and indeed they exercise that legal right. In short, the explicit assignment of rights even to a continuation-in-part application recited in the Shields' Assignment (EXHIBIT 1) overrides the general prohibition quoted-above in MPEP §306. Note that MPEP §306 does not say that a prior assignment can never carry-over to a continuation-in-part application, or that it shall not carry-over. Instead, MPEP §306 states that in general there is no automatic carry-over because what was assigned only gave assignee rights to subject matter common to both applications. But in EXHIBIT 1, what was explicitly assigned did include Shields' rights to subject matter included in a continuation-in-part. (Indeed, as demonstrated later herein, Shields is named inventor on three U.S. patents, all of which are assigned to Creative Minds Foundation.)

In short, it is submitted that the Examiner's objection to the Revocation and Power of Attorney document on file herein, as enunciated at ¶¶1-4 of the Office Action must be withdrawn. The generalized language of MPEP §306 is trumped by the very explicit language of the Shields Assignment. In view of Mr. Shields' continuing pattern of non-cooperation, and in view of his assignment of the underlying invention, patent, including continuations in whole or in part and reissue applications to Assignee Creative Minds Foundation. Creative Minds Foundation has a legal right to execute documents in a continuation-in-part application on behalf of the absent or non-cooperating Mr. Shields.

**B. THE CLAIM OF MS. ICARD TO BE AN INVENTOR
HEREIN IS A SPURIOUS CLAIM**

At ¶6 of the Office Action, the Examiner rejects the pending claims under 35 USC 102(f) on the grounds that a Ms. Icard rather than applicant Rodney Shields

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may have invented the claimed subject matter. More specifically, at page 5 of the Office Action, the Examiner relies upon various self-serving statements by Ms. Icard in support of the proposition that the pending claims should be rejected under 35 USC 102(f).

Assignee will now demonstrate objectively that the claim of inventorship on the part of Ms. Icard is simply not warranted, and indeed is spurious.

(1) Shields's parent application serial no. 82,728 was filed with the USPTO on 23 June 1993, which predates any meeting between Ms. Icard and any of Messrs. Shields, Ross, or Luckman re the above-referenced Shields patent application; see also Ross Declaration filed herewith.

(2) Assignee points out that Figs. 1, 4, and 5 in the said Shields application depict unperforated panels or layers comprising the invention;

(3) Further, assignee points out that the said Shields application at page 2, lines 31-35 states:

The panels are stacked together after the image has been placed on the one panel and the black or dark coating has been placed on the other panel. The panels are provided with holes therethrough. The holes can be placed through the panels either before or after they are assembled. (emphasis added)

(5) Assignee points out that claim 14 in the original Shields application recites:

An assembly as set forth in Claim 1, wherein said panel is formed from static cling material. (emphasis added)

Consider now the following statements from the Icard Affidavit, executed on 11 November 1999:

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(1) At page 3, ¶2 Icard makes reference to licenses offered by ImagolImage, Inc. for a patent application for forming one-way see-through images on perforated plastic sheeting. At page 5 ¶4 of her Affidavit, Ms. Icard states in August 1993 she and her husband traveled to San Francisco to learn more about the license and met with Greg Ross, Rodney Shields, and Michael Luckman, on behalf of ImagolImage, Inc.

(a) Applicant points out on 26 July 1993 Ms. Icard as President of Visual Technologies, Inc. executed a Confidential Non-Disclosure Agreement with ImagolImage, Inc., see EXHIBIT 2 herein. Further, on 16 September 1993, Clear Choice Marketing (Ms. Linda Icard, President) licensed the above-referenced Shields's patent application and invention from ImagolImage, Inc. See EXHIBIT 3 herein. The Ross Declaration submitted herewith states that license fees were in fact paid by Ms. Icard's company under EXHIBIT 3.

(b) Stated differently, to the extent Ms. Icard regards herself as an inventor of any part of the Shields's invention, why would she enter into a license for "her own" invention?

(2) At page 6, §5 and §6, Ms. Icard says she immediately told Messrs. Ross, Shields, and Luckman that the "perforated" invention at hand would not lend itself to printing using a "vacuum bed". Ms. Icard states she also told Messrs. Ross, Shields, and Luckman that advertisers would not in practice care to adhere perforated material to the "outside of a store window". According to Ms. Icard's Affidavit at page 6, §6, Messrs. Shields, Ross, and Luckman were "visibly disturbed by these problems and indicated that they had not anticipated or recognized such problems nor did they have any ideas as to how to potentially overcome the problems".

(3) In her Affidavit at page 7, §8, Ms. Icard states that she recognized that "black was a preferably color to gray" to improve vision through a one-way vision panel. At page 18, §10 of her Affidavit, Ms. Icard notes her use of a clear static vinyl product, and indeed apparently documents her purchase of such material in September 1993. But the Shields application, which was filed before Ms. Icard entered the scene, discloses the use of "static cling material", e.g., see as-filed claim 14.

(c) That Ms. Icard's above-referenced statements are overstated is self-evident from reviewing the as-filed text of the Shields's application serial no. 82,728, filed with the USPTO on 23 June 1993. As noted, the application, which was filed before Ms. Icard first met with Shields, Ross, and Luckman, discloses use of non-perforated panels, and panels that are printed first and perforated second, thus overcoming any problems perceived by Ms. Icard re use of a "vacuum bed". Further, the Shields's application as-filed with the USPTO before Ms. Icard ever entered the scene discloses use of "black" color (see application, page 7, lines 28-30, inter alia.) Claim 14 in the as-filed Shields's application discloses the use of "static cling material".

(d) In short, Ms. Icard's statements in her Affidavit are repudiated by the very text and figures in the Shields patent application. But what is more, Icard's company in fact licensed under the Shields patent application (see EXHIBITS 2 and 3 and Ross Declaration, filed herewith).

* * * * *

It is submitted that the Icard Affidavit does not establish Ms. Icard's right to be named as an inventor herein, and certainly must not be allowed to sidetrack this application. It is submitted that the rejection without substantial examination of the pending claims based upon 35 USC 102(f) must be withdrawn. The pending claims should be examined at this time.

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